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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/513,646	02/25/2000	DANIEL A FORD	AM9-99-0165	7164

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EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 10/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/513,646

Applicant(s)

FORD ET AL.

Examiner

Ovidio Escalante

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. The drawings submitted on February 25, 2000 have been approved by the draftsman.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1,3,5,7,10 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Gazdzinski US Patent 6,615,175.

Regarding claims 1,5 and 10, Gazdzinski teaches a method, program storage device readable by a machine to perform the method steps and a system comprising means for interjecting messages into a real-time isochronous discourse between a plurality of users (passengers), (col. 20, lines 42-57) comprising:

providing a system (advertising sub-system) for accessing a real-time isochronous discourse between two or more callers, (col. 20, lines 59-62);

accessing a real-time isochronous discourse between two or more callers (passengers), (col. 20, lines 59-62);

monitoring the discourse between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system, (col. 20, line 59-col. 21, line 5); and

communicating the desired message to the callers when the discourse is determined to be related to the desired message, (col. 21, lines 14-43); and

continuing the above steps until the discourse being accessed is terminated by the callers or the system, (col. 21, lines 44-55).

Regarding claims 3 and 7, Gazdzinski teaches a method, program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform the method and a system comprising means for interjecting messages into a real-time isochronous discourse between a plurality of callers (passengers), (col. 6, lines 39-50; col. 20, lines 42-57) is provided comprising:

forming a system (fig. 1) comprising:

a system interface for inputting and storing system parameters by an owner of the system, (col. 4, lines 21-31; col. 7, lines 44-55);

a communication media interface for communicating with an isochronous communication system (121) being used by two or more callers, (col. 20, lines 43-58);

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a conversation content analyzer and summarizer for determining if the communication between the callers is relevant to the system parameters, (col. 20, line 59-col. 21, line 10);

a database for storing system data including system messages to be transmitted to the callers, (col. 20, lines 63-66; col. 21, lines 25-43);

a database manager for matching system parameters with the communication between the callers, (col. 21, lines 5-25); and

a caller interface (111,113) for communicating the system data and/or messages to one or more of the callers, (col. 21, lines 34-55);

accessing the isochronous communication system being used by two or more callers using the communication media interface, (col. 20, lines 59-62);

monitoring the communication between the callers using the communication media interface, (col. 20, line 59-col. 21, line 5);

analyzing the conversation using the conversation content analyzer and summarizer, (col. 20, lines 43-48);

determining if there is a match between the conversation and one or more of the system parameters using the database manager, (col. 20, line 59-col. 21, line 5);

sending the system data from the database to the database manager if there is a match and choosing a suitable message from the database for communication to the callers, (col. 21, lines 5-34); and

transmitting the message to the callers using the caller interface, (col. 21, lines 14-43).

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawyer US Patent 6,351,279 in view of Gazdzinski US Patent 6,615,175.

Regarding claims 1, 5 and 10, Sawyer teaches a method, program storage device readable by a machine to perform the method steps and a system comprising means for interjecting messages into a real-time isochronous discourse between a plurality of users (abstract; col. 1, lines 63-65; col. 3, lines 29-52) comprising:

providing a system for accessing a real-time isochronous discourse between two or more callers, (col. 3, lines 29-52);

accessing a real-time isochronous discourse between two or more callers, (col. 3, lines 29-52).

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Sawyer does not specifically teach of monitoring the discourse between the callers and communication a message related to the discourse.

Gazdzinski teaches that it was well known in the art to monitor the discourse between callers to determine if the discourse relates to a message desired to be communicated to the callers by the system, (col. 20, line 59-col. 21, line 5); and communicating the desired message to the callers when the discourse is determined to be related to the desired message, (col. 21, lines 14-43); and continuing the above steps until the discourse being accessed is terminated by the callers or the system, (col. 21, lines 44-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sawyer by monitoring the conversation of the callers and providing a message based on their conversation as taught by Gazdzinski so that the system can provide adaptive advertisements that is based upon the users interest at the time that the conversation takes place.

Regarding claims 2,4,6,8,11,13, Sawyer, as applied above, further teaches wherein the real-time isochronous discourse is a telephone call, (video telephone; abstract).

Regarding claims 3 and 7, Sawyer teaches a method, program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform the method and a system comprising means for interjecting messages into a real-time isochronous discourse between a plurality of callers is provided (abstract; col. 1, line 63-65; col. 3, lines 29-52) comprising:

forming a system comprising:

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a system interface for inputting and storing system parameters by an owner of the system, (col. 4, lines 8-32);

a communication media interface for communicating with an isochronous communication system being used by two or more callers, (col. 2, line 63-col. 3, line 8; fig. 3);

a database for storing system data including system messages to be transmitted to the callers, (col. 3, lines 9-28);

a caller interface for communicating the system data and/or messages to one or more of the callers, (col. 3, lines 9-8, col. 4, lines 33-50).

Sawyer does not specifically teach of a conversation analyzer and choosing a message based on the conversation.

Gazdzinski teaches that it was well known in the art to have a conversation content analyzer and summarizer for determining if the communication between the callers is relevant to the system parameters, (col. 20, line 59-col. 21, line 10);

a database manager for matching system parameters with the communication between the callers, (col. 21, lines 5-25); and

accessing the isochronous communication system being used by two or more callers using the communication media interface, (col. 20, lines 59-62);

monitoring the communication between the callers using the communication media interface, (col. 20, line 59-col. 21, line 5);

analyzing the conversation using the conversation content analyzer and summarizer, (col. 20, lines 43-48);

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determining if there is a match between the conversation and one or more of the system parameters using the database manager, (col. 20, line 59-col. 21, line 5);

sending the system data from the database to the database manager if there is a match and choosing a suitable message from the database for communication to the callers, (col. 21, lines 5-34); and

transmitting the message to the callers using the caller interface, (col. 21, lines 14-43).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sawyer by using a conversation analyzer to provide the callers with customized announcements based on their conversation as taught by Gazdzinski so that the system can provide adaptive advertisements that is based upon the users interest at the time that the conversation takes place.

Regarding claim 9, Sawyer teaches wherein different messages are provided to each caller, (col. 4, lines 7-22).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ford et al. US Patent 6,606,644 teaches of a method and apparatus for generating advertisements based upon a live conversation between a plurality of users which are communicating in real-time.

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Matsubara et al. US Patent Application Publication 2001/0022788 teaches of a communication system for detecting keywords in a speech of a user and to determine advertisements to play to the user based on the keywords.

Goldman et al. US Patent Application Publication 2003/0135853 teaches of a method and system for inserting advertisements based upon keywords.

Yu, C Y Korean Publication 2002007780 teaches of targeting advertisements in accordance with a voice data analysis and displaying the advertisements based upon the contents of the voice.

Kim J Y Korean Publication 2002024909 teaches of an advertisement method which recognizes keywords and will display a banner that is associated with the keyword.

Nakazawa Japanese Publication 2000039804 teaches of providing advertisements based upon keywords spoken in a chat environment.

Takeuchi, Shunichi Japanese Publication 2002271507 teaches of extracting keywords from a conversation and displaying an advertisement based upon the keywords.

8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 872-9314, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is (703) 308-6262. The examiner can normally be reached on Monday to Friday from 6:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. The fax phone number for this Group is (703) 872-9314.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [fan.tsang@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ovidio Escalante
Examiner
Group 2645
September 29, 2003

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

